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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/723,040

11/26/2003

Keith C. Hullfish

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EXAMINER

BHATIA, AJAY M

ART UNIT

PAPER NUMBER

2145

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/723,040

Applicant(s)

HULLFISH ET AL.

Examiner

Ajay M. Bhatia

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/8/06</u> . | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

Applicant's arguments with respect to claims 1-61 have been considered but are moot in view of the new ground(s) of rejection. Applicant has filed an RCE 10/26/06.

Additionally applicant requested further clarification of the 101 rejection, examiner provided additional information in the 101 rejection bellow.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 22, 42 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,12,15 of U.S. Patent No. 6,714,793. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the narrower claims in the Patent anticipates the broader claims of the current pending application. Exemplarily claims 1 from both applications is provided bellow.

Patent 6,714,793	Instant application 10/0723,040	
A method for instant text message communication, said method comprising: sending an instant text message from a cellular communications device in wireless communication with components of a wireless environment that are coupled to an instant message system, said text message including a destination address, information associated with the cellular communications device's user, message content and message address;	1. A method of transmitting electronic messages in a computer environment, comprising the steps of: receiving an electronic message addressed to a telephone number;	A cellular device inherently has a telephone number
according to information	determining an instant	Telephone number

previously stored for the cellular communications device's user at the instant message system, if the destination address is associated with an instant message function, executing the associated instant message function at the instant message system using the information contained in the message content, if required as determined by the associated instant message function;	message identifier associated with the telephone number;	addressed above
and if the destination address is associated with an instant message user name, creating an instant text message comprising the message content and	determining whether an instant message receiver is available to receive messages addressed to the instant message identifier; forwarding the electronic	If is equivalent to determining

sending the created instant text message to the associated instant message name.	message as an instant message addressed to the instant message identifier in response to a determination that an instant message receiver is available to receive instant messages addressed to the instant message identifier; and	
	sending the electronic message to a mobile device at the telephone number in response to a determination that no instant message receiver is available to receive instant messages addressed to the instant message identifier.	One of skill in the art that it is well known to forward message is the IM user in "away" mode

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-61 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. The claim fail to produce according to all possible scenarios a "specific machine to produce a useful, concrete, and tangible result." Presently the computer does not produce a tangible result the entire processing is done within a single computer and therefore no tangible result is created.

Additionally clarification:

Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions.

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Computer programs are often recited as part of a claim. USPTO personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program. Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material per se and hence nonstatutory.

Applicant has claimed instant messages, and a telephone number, but no statutory machine or manufacture is present in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-61 are rejected under 35 U.S.C. 102(e) as being anticipated by Dehlin (U.S. Patent 6,957,077).

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For claim 1, Dehlin teaches, a method of transmitting electronic messages in a computer environment, comprising the steps of:

- receiving an electronic message addressed to a telephone number; (Dehlin, Col. 6 lines 12-27, cell phone)

- determining an instant message identifier associated with the telephone number; (Dehlin, Col. 6 lines 35-47, alias)

- determining in real time whether an instant message receiver is currently available to receive messages addressed to the instant message identifier; (Dehlin, Col. 5 lines 13-21, msn messenger, Col. 7 lines 20-25, chat)

- and performing a step from a group of steps consisting of:

- forwarding the electronic message as an instant message addressed to the instant message identifier in response to a determination that an instant message receiver is available to receive instant messages addressed to the instant message identifier; (Dehlin, Col. 6 lines 35-60, alias status, computing device)

- and sending the electronic message to a mobile device at the telephone number in response to a determination that no instant message receiver is available to receive instant messages addressed to the instant message identifier. (Dehlin, Col. 6 lines 35-60, mobile device)

For claim 2, Dehlin teaches, the method of claim 1, wherein the electronic message comprises any of:

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a text message, an SMS text message, an MMS message, a video message, and an audio message. (Dehlin, Col. 5 lines 1-5, sms)

For claim 3, Dehlin teaches, the method of claim 1, wherein the instant message is received at an electronic device configured to receive instant messages addressed to the instant message identifier. (Dehlin, Col. 6 lines 35-60, alias)

For claim 4, Dehlin teaches, the method of claim 3, wherein the electronic device comprises any of:

a computer, a personal data assistant (PDA), and a telephone receiver. (Dehlin, Col. 6 lines 12-27, cell phone)

For claim 5, Dehlin teaches, the method of claim 1, wherein the determining the instant message identifier comprises searching for the instant message identifier associated with the telephone number in a database. (Dehlin, Col. 6 lines 35-60, alias, database)

For claim 6, Dehlin teaches, the method of claim 1, further comprising the step of:

determining whether or not to forward the electronic message as an email message addressed to an email address according to a user preference stored in a database. (Dehlin,)

For claim 7, Dehlin teaches, the method of claim 1, further comprising the step of:

determining whether or not to forward the electronic message as an instant message addressed to the instant message identifier according to a user preference stored in a database. (Dehlin, Col. 5 lines 13-21)

For claim 8, Dehlin teaches, the method of claim 7, wherein the determining whether or not to forward is further based on source information of the electronic message. (Dehlin, Col. 6 lines 35-60, database, Col. 7 lines 4-15, sleep)

For claim 9, Dehlin teaches, the method of claim 8, wherein the source information comprises any of:

a source address of the electronic message, a user name of a sender of the electronic message, a telephone number of a sender of the electronic message, and an instant message identifier of a sender of the electronic message. (Dehlin, Col. 6 lines 35-60, alias)

For claim 10, Dehlin teaches, the method of claim 1, wherein the instant message is generated from the electronic message based on one or more predetermined rules. (Dehlin, Col. 7 lines 20-30, message)

For claim 11, Dehlin teaches, the method of claim 10, wherein the one or more predetermined rules select one or more portions of the electronic message as the instant message. (Dehlin, Col. 7 lines 47-52, sms mobile device)

For claim 12, Dehlin teaches, the method of claim 10, wherein the one or more predetermined rules selectively delete one or more portions of the electronic message to generate the instant message. (Dehlin, Col. 7 lines 47-52, sms mobile device)

For claim 13, Dehlin teaches, the method of claim 1, further comprising the step of forwarding the electronic message to a storage medium. (Dehlin, Col. 7 lines 41-46, reply)

For claim 14, Dehlin teaches, the method of claim 1, further comprising the step of storing the electronic message in the storage medium. (Dehlin, Col. 7 lines 32-40, computer)

For claim 15, Dehlin teaches, the method of claim 1, further comprising the step of:
determining whether or not to forward the electronic message to the storage medium according to the user preference stored in the database. (Dehlin, Col. 6 lines 35-60, database, Col. 7 lines 4-15, sleep)

For claim 16, Dehlin teaches, the method of claim 1, further comprising the step of:
forwarding the electronic message to the storage medium when the forwarding to the mail address and the instant message identifier fails . (Dehlin, Col. 6 lines 35-60, database, Col. 7 lines 4-15, sleep)

For claim 17, Dehlin teaches, the method of claim 15, wherein the determining whether or not to forward is further based on source information of the electronic message. (Dehlin,) Col. 6 lines 35-60, database, Col. 7 lines 4-15, sleep

For claim 18, Dehlin teaches, the method of claim 15, wherein the user preference stored in the database comprises date and time preference of the instant message receiver. (Dehlin,)

For claim 19, Dehlin teaches, the method of claim 1, further comprises the step of logging the forwarding the electronic message. (Dehlin, Col. 7 line 66 to Col. 8 line 11, sms)

For claim 20, Dehlin teaches, the method of claim 1, further comprises blocking the forwarding of the electronic messages based on a list of telephone numbers. (Dehlin, Col. 6 lines 35-60, alais)

For claim 21, Dehlin teaches, the method of claim 1, wherein the forwarding is based on the one or more predetermined rules. (Dehlin, Col. 7 lines 47-55, customize)

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Claims 22-60 list all the same elements of claims 1-21, relating to the same invention.

Therefore, the supporting rationale of the rejection to claims 1-21 applies equally as well to claims 22-60.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached Notice of references cited (if appropriate).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajay M. Bhatia whose telephone number is (571)-272-3906. The examiner can normally be reached on M-F 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571)272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

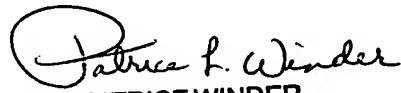
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



AB

Jason Cardone
Supervisor Patent Examiner
Art Unit 2145



PATRICE WINDER
PRIMARY EXAMINER

for
